The Office has characterized the relationship between Groups I and II as product and process of use. Citing MPEP §806.05(h), the Examiner states that claims in this relationship can be shown to be distinct if either of the following can be shown: (1) that process **as claimed** can be practiced with another materially different product; or (2) that the product as claimed can be used in a materially different process. The Examiner goes on to state that, in the present application, the product can be used "by a method wherein the magnet is moved within the tube and the product is held stationary." Applicant submits that the reasons offered by the Examiner are insufficient to support a conclusion of patentable distinctness between the restricted claims. As discussed on page 26 in the section titled "Method of Use," the magnet must be fixed at a known position within the cannula of the intra-medullary nail (IMN), proximal to the screw holes. Because of the detailed nature of orthopedic surgery, the exact location of the magnet, and thus the screw holes in the IMN, must be known to the surgeon. If the magnet were movable within the IMN, the surgeon would not be able to determine where to drill into the bone to affix the screws. The Examiner has provided no indication as to the medical feasibility of using a movable magnet, during an orthopedic surgery, to locate a fixed position in a human bone.

The Office has characterized the relationship between Groups I and III as related products. Citing MPEP §806.05(j), the Examiner states that claims in this relationship can be shown to be distinct if the following can be shown: (1) that inventions **as claimed** are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; **and** (3) the inventions as claimed are not obvious variants. The Examiner goes on to state that because invention III requires an elliptical array of sensors not required for invention I, the inventions have materially different designs and do not overlap in scope. Applicant submits that the reasons offered by the Examiner are insufficient to support a conclusion of patentable distinctness between the restricted claims. The inventions, **as claimed**, are capable of use together, have materially similar designs, modes of operation and function, and they overlap in scope. Both inventions are directed to a long, hollow IMN (a tube) incorporating a magnet within the cannula used to locate screw hole positions within a femur, or other long bone, during a surgical procedure. The addition of the elliptical array of sensors to invention III is an obvious variant to invention I.

The Office has characterized the relationship between Groups I and IV as product and process of use. Citing MPEP §806.05(h), the Examiner states that claims in this relationship can be shown to be distinct if either of the following can be shown: (1) that process **as claimed** can be practiced with another materially different product; or (2) that the product as claimed can be used in a materially different process. The Examiner goes on to state that, in the present application, the product can be used "by a method wherein the magnet is moved within the tube and the product is held stationary." Applicant submits that the reasons offered by the Examiner are insufficient to support a conclusion of patentable distinctness between the restricted claims. As discussed on page 26 in the section titled "Method of Use," the magnet must be fixed at a known position within the cannula of the intra-medullary nail (IMN), proximal to the screw holes. Because of the detailed nature of orthopedic surgery, the exact location of the magnet, and thus the screw holes in the IMN, must be known to the surgeon. If the magnet were movable within the IMN, the surgeon would not be able to determine where to drill into the bone to affix the screws. The Examiner has provided no indication as to the medical feasibility of using a movable magnet, during an orthopedic surgery, to locate a fixed position in a human bone.

The Office has characterized the relationship between Groups III and II as product and process of use. Citing MPEP §806.05(h), the Examiner states that claims in this relationship can be shown to be distinct if either of the following can be shown: (1) that process **as claimed** can be practiced with another materially different product; or (2) that the product as claimed can be used in a materially different process. The Examiner goes on to state that, in the present application, the product can be used "by a method wherein the magnet is moved within the tube and the product is held stationary." Applicant submits that the reasons offered by the Examiner are insufficient to support a conclusion of patentable distinctness between the restricted claims. As discussed on page 26 in the section titled "Method of Use," the magnet must be fixed at a known position within the cannula of the intra-medullary nail (IMN), proximal to the screw holes. Because of the detailed nature of orthopedic surgery, the exact location of the magnet, and thus the screw holes in the IMN, must be known to the surgeon. If the magnet were movable within the IMN, the surgeon would not be able to determine where to drill into the bone to affix the screws. The Examiner has provided no indication as to the medical feasibility of using a movable magnet, during an orthopedic surgery, to locate a fixed position in a human bone.

The Office has characterized the relationship between Groups II and IV as related processes. Citing MPEP §806.05(j), the Examiner states that claims in this relationship can be shown to be distinct if the following can be shown: (1) that inventions **as claimed** are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; **and** (3) the inventions as claimed are not obvious variants. The Examiner goes on to state that because invention IV requires an elliptical array of sensors not required for invention II, the inventions have materially different designs and do not overlap in scope. Applicant submits that the reasons offered by the Examiner are insufficient to support a conclusion of patentable distinctness between the restricted claims. The inventions, **as claimed**, are capable of use together, have materially similar designs, modes of operation and function, and they overlap in scope. Both inventions are directed to a method for locating the precise location and position of a target device within a long, hollow object (IMN) using a magnet within the cannula of the long object and moving an external target device along the femur, or other long bone, during a surgical procedure. Both inventions are designed to locate the screw holes in the long object. The addition of the elliptical array of sensors to invention IV is an obvious variant to invention II.

The Office has characterized the relationship between Groups III and IV as product and process of use. Citing MPEP §806.05(h), the Examiner states that claims in this relationship can be shown to be distinct if either of the following can be shown: (1) that process **as claimed** can be practiced with another materially different product; or (2) that the product as claimed can be used in a materially different process. The Examiner goes on to state that, in the present application, the product can be used "by a method wherein the magnet is moved within the tube and the product is held stationary." Applicant submits that the reasons offered by the Examiner are insufficient to support a conclusion of patentable distinctness between the restricted claims. As discussed on page 26 in the section titled "Method of Use," the magnet must be fixed at a known position within the cannula of the intra-medullary nail (IMN), proximal to the screw holes. Because of the detailed nature of orthopedic surgery, the exact location of the magnet, and thus the screw holes in the IMN, must be known to the surgeon. If the magnet were movable within the IMN, the surgeon would not be able to determine where to drill into the bone to affix the screws. The Examiner has provided no indication as to the medical feasibility of using a movable magnet, during an orthopedic surgery, to locate a fixed position in a human bone.

Accordingly, because the Office has not carried the burden of providing technologically sound reasons or examples for concluding that the claims of the restricted groups are patentably distinct, the restriction requirement is improper and should be withdrawn.

Applicants explicitly reserve their right to rejoin suitable method claims upon an indication of allowable product claims. See *In re Ochiai*, 37 USPQ2d 1127, and *In re Brouwer*, 37 USPQ2d 1663.

Applicants submit the application is now ready for examination on the merits. Early notification of such action is earnestly solicited.

Should the Examiner have any questions or comments with respect to the application, the Examiner is requested to contact the undersigned attorney. The attorney welcomes and encourages telephone calls related to this application because this may allow the resolution of disputed claim language and/or other informalities more rapidly and efficiently than by any other means. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

Respectfully submitted,

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